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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,692	09/17/2001	Peter X. Ma	UMJ-105-B (UM1667)	9241
29296	7590	11/20/2003	EXAMINER	
JULIA CHURCH DIERKER DIERKER & GLASSMEYER, P.C. 3331 W. BIG BEAVER RD., SUITE 109 TROY, MI 48084-2813			SZEKELY, PETER A	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 11/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,692

Applicant(s)

MA ET AL.

Examiner

Peter Szekely

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
4a) Of the above claim(s) 32-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 32-49 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The original claims are directed to a composition classified in class 523, subclasses 116-117, while the newly added claims are directed to a method of making the composition classified in class 433, subclass 222.1.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 32-49 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7, 8, 10 and 22-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The phrases "hydrophilic derivatives" and "hydrophilic derivatives" render the claims indefinite. There is nothing in the instant specification to indicate what these derivatives might be and which derivatives are suitable or unsuitable for the desired application. See also: *Petrolite Corporation v. Watson*, Comr. Pats. (DC DC) 113 USPQ

248 and Austenal Laboratories, Incorporated v. Nobileium Processing Company of Chicago et al. (DC NIII) 115 USPQ 44.

Claim Rejections - 35 USC § 102

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 1-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Tezulka et al. 4,089,830, Wilson et al. 4,569,954, Wilson et al. 4,758,612, Okayabashi et al, 5,051,453, Kato et al. 5,520,725 or National Res Dev Corp GB 1,507,981.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
8. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Tezulka et al. 4,089,830, Wilson et al. 4,569,954, Wilson et al. 4,758,612, Okayabashi et al, 5,051,453, Kato et al. 5,520,725 or National Res Dev Corp GB 1,507,981.

Response to Arguments

9. Applicant's arguments filed 9/16/03 have been fully considered but they are not persuasive. All the cited references show the different monomers in a predetermined ratio. The very existence of a copolymer proves that. The fact that a copolymer containing a higher percentage of hydrophilic monomer is going to be more water soluble and that a copolymer containing more hydrophobic monomer is less water soluble is a law of physics and as such it has no patentable significance. There is nothing in the claims to indicate the amount of hydrophobic and hydrophilic monomers

in the claimed copolymer. On the other hand, for example Wilson et al. ('612) specify 5-70% water insoluble monomer in column 5, lines 50-59. Claim 18 of Engelbrecht specifically requires monomers which do not hydrolyze. In column 9, lines 3-10 of the reference it is stated that 5% of acid containing monomers is sufficient. Okabayashi et al. also relate a copolymer containing as little as 5% acid containing monomer. See column 3, lines 1-13. The same 5% acidic monomer content is shown in claim 1 of Kato et al. Applicants' specification, on the other hand requires only 1% hydrophobic monomer on page 13, lines 16-28. There is nothing in the claims to indicate whether the claimed copolymer is hydrophilic or hydrophobic. There is no statement in the claims that the resulting copolymer should not be water soluble. The rejections are maintained.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (703) 308-2460. The examiner can normally be reached on 7:00 a.m.-5:30 p.m. Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Peter Szekely
Primary Examiner
Art Unit 1714

P.S.
11/17/03